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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,657	06/29/2001	Victor R. Herrero	POU920010051US1	8494
23334	7590	02/27/2006	EXAMINER	
FLEIT, KAIN, GIBBONS, GUTMAN, BONGINI & BIANCO P.L. ONE BOCA COMMERCE CENTER 551 NORTHWEST 77TH STREET, SUITE 111 BOCA RATON, FL 33487			ROCHE, TRENTON J	
			ART UNIT	PAPER NUMBER
			2193	

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/896,657	HERRERO, VICTOR R.
	Examiner	Art Unit
	Trenton J. Roche	2193

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 25 November 2005.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-15 and 17 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) 1-8 and 12-14 is/are allowed.

6) Claim(s) 9-11,15 and 17 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 29 June 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

DETAILED ACTION

1. This office action is responsive to communications filed 25 November 2005.
2. Per Applicant's request, amended claims 1-3, 5-12, 14, 15 and 17 have been entered. Claims 1-15 and 17 are pending.
3. Claims 1-15 and 17 have been examined.

Response to Arguments

4. Applicant's arguments with respect to claims 1-8 and 12-14 have been considered and are persuasive. Consequently, the rejection of claims 1-8 and 12-14 under 35 U.S.C. § 103(a) has been withdrawn. However, Applicant's arguments with respect to claims 9-11, 15 and 17 are not found to be persuasive.

Regarding claims 9-11, 15 and 17:

The Applicant states that Eberhard teaches away from the instant application in that the publications disclosed in Eberhard reside at a publisher server, and that the instant application "allows for the presence of hundreds of software 'staging servers' located around the world..." (page 15 of the Remarks). However, according to the broadest reasonable interpretation of the claim language, the Examiner finds no differentiation in the claims as to how the publisher server would be any different from the staging server of the present invention, as they both exist to provide the client with the desired product, and indeed no mention is made for a requirement to have several hundred staging servers around the world. As the claims provide no basis in language for why Eberhard would teach away from the present invention, the Examiner considers these comments mere allegations of patentability. The Applicant further states that the entitlement ID is originated

by the software ordering server in the instant application, whereas Eberhard discloses a reader ID originating from the client system. In response, the Examiner notes that the reader ID is sent from the client system to the retailer's server, which is in turn forwarded on to the authentication server. As such, according to the broadest reasonable interpretation of the claim language, the reader ID is originating from the retailer server (corresponding to the software ordering server) when it is sent on to the authentication server, as it is not sent directly to the authentication server from the client system. Consequently, Eberhard discloses the ID originating from the ordering server. Finally, Applicants arguments that there is no suggestion or teaching in the prior art for the combination of Eberhard and Fawcett are considered mere allegations of patentability, as no clear error was pointed out in the reasoning beyond reciting a general allegation that the suggestion may have originated from Applicant's own specification. As noted in the rejection, the Examiner cited motivation as to why one of ordinary skill in the art would be motivated to combine the reference, and as such, the rejection of claims 9-11, 15 and 17 is proper and maintained.

Allowable Subject Matter

5. Claims 1-8 and 12-14 are allowed.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 9-11, 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2001/0011238 A1 to Eberhard et al. (hereinafter "Eberhard"), in view of U.S. Patent 5,845,077 to Fawcett.

Per claim 9:

Eberhard discloses:

- receiving from a product ordering server, an entitlement ID for authorizing the use of the product which has been previously ordered on a client system, wherein the product ordering server originates the entitlement ID ("The retailer server...responds to a purchase request from a user...In addition, the ID of the reader and the indicia of the requested publication...is supplied to an authentication server...The authentication server...typically passes to the publisher server...a confirmed request for a file..." in paragraph 0025. Further, note Figure 2B, item 258. The reader ID is sent from the retailer server to the authentication server and publisher server, and as such, the ID originates from the ordering server.)
- receiving a request from the client system for the download of a copy of the at least one product to the client system, wherein the request includes an entitlement ID used to order the software file (Note Figure 2B, items 262 and 222 and the corresponding sections of the disclosure.)
- verifying that the entitlement ID received from the ordering server matches the entitlement ID used to order the at least one file (Note Figure 2B, item 224 and the corresponding sections of the disclosure.)
- scheduling the download of the requested product from a staging server to the client system (Note Figure 2B, item 228 and the corresponding sections of the disclosure.)

substantially as claimed. Eberhard does not explicitly disclose that the product is software, nor does Eberhard disclose verifying the client system's PC compatibility for the requested copy of at least one software file. Fawcett discloses in an analogous client/server user-selection update system the ability to enable a user to view and purchase software for installation and checking the client system's PC compatibility as claimed ("a user selection of desired software..." in col. 11 lines 60-61. Further, note Figure 4A, item 72 and the corresponding sections of the disclosure.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the distribution system of Eberhard to allow software distribution and installation as described by Fawcett, as this would allow a user to purchase and install software easily via the Internet, further allowing publishers to maintain custody of their exclusive content and ensure protection of the publisher's rights, as noted in paragraph 0009 and 0010 of Eberhard.

Per claim 10:

The rejection of claim 9 is incorporated, and further, Eberhard does not explicitly disclose requesting system information as claimed. Fawcett discloses the ability to request system information as claimed (Note at least Figure 4A, item 70 and the corresponding sections of the disclosure). It would have been obvious to one of ordinary skill in the art at the time the invention was made to request system information as disclosed by Fawcett to a product distribution server as disclosed by Eberhard, as this would allow the product server to identify new computer software, patches, and fixes required by the client, as disclosed by Fawcett in col. 7 lines 23-44.

Per claim 11:

Eberhard discloses:

- receiving an order entitlement ID for at least one product, which has been previously ordered from a client system on a product ordering server, wherein the product ordering system originates the entitlement ID (“The retailer server...responds to a purchase request from a user...In addition, the ID of the reader and the indicia of the requested publication...is supplied to an authentication server...The authentication server...typically passes to the publisher server...a confirmed request for a file...” in paragraph 0025. Further, note Figure 2B, item 258. Further, note Figure 2B, item 258. The reader ID is sent from the retailer server to the authentication server and publisher server, and as such, the ID originates from the ordering server.)
- storing the entitlement ID for at least one product in a database (“provides the customer or reader specific indicia...to the retailer’s server...this information can be...stored...on the server...” in paragraph 0024)
- receiving a request for the down-load of at least one requested product with a download entitlement ID from a client system (Note Figure 2B, items 262 and 222 and the corresponding sections of the disclosure.)
- determining if the downloaded entitlement ID matches the order entitlement ID previously stored in the database, and in response to the order entitlement ID matching the download entitlement ID; and scheduling a response to the request for a copy of the at least one product at a scheduling server (Note Figure 2B, items 262, 222, 224, and 228 and the corresponding sections of the disclosure.)

substantially as claimed. Eberhard does not explicitly disclose that the product is software, nor does Eberhard disclose the installation of the software product after receiving the software product. Fawcett discloses in an analogous client/server user-selection update system the ability to enable a

user to view and purchase software for installation and to automatically install the application independently of the user (“a user selection of desired software...” in col. 11 lines 60-61. Further, “downloading the desired software to the first computer, and installing the desired software on the first computer...” in col. 12 lines 42-44). It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the distribution system of Eberhard to allow software distribution and installation as described by Fawcett, as this allow a user to purchase and install software easily via the Internet, further allowing publishers to maintain custody of their exclusive content and ensure protection of the publisher’s rights, as noted in paragraph 0009 and 0010 of Eberhard.

Per claims 15 and 17:

Claims 15 and 17 do not further disclose or teach any new matter beyond that which is disclosed in independent claim 11, and are therefore rejected under the same rationale as claim 11.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

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calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trenton J. Roche whose telephone number is (571) 272-3733. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571) 272-3719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Trenton J Roche
Examiner
Art Unit 2193

TJR

Kakali Chaki

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